UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,722	12/28/2001	Lester Benjamin Johnson	87354.1581	4118

30734 7590 01/19/2007

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/028,722	JOHNSON ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12/13/06* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's response of 12/13/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-19 are directed to method steps that are using structure recited in apparatus claim 16. This is improper because these claims then appear to be directed to both an apparatus and the method of using that apparatus. Claims must fall into only one statutory class of invention at one time to be considered statutory. These claims are mixing two different statutory classes of invention, which renders them as non-statutory.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 16-19, it is not clear as to what statutory class of invention the claims fall into. Claims 16-19 are directed to method steps that are using structure recited in apparatus claim 16 (i.e. the data input **receives vehicle diagnostic data over a**

wireless communications link"). This is improper because these claims then appear to be directed to both an apparatus and the method of using that apparatus. One wishing to avoid infringement would not know whether just having the system would constitute infringement, or if having the claimed system and performing the claimed steps would constitute infringement. Are these claims method claims or apparatus claims? This is not clear and renders the claims indefinite.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4,6-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Li (20020072808).

For claims 1,2,4,11, Li discloses a system and method for providing vehicle information. Li discloses a system where a user (vehicle owner or automotive service associate) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem. See figure 17 and paragraph 61 where it is disclosed that vehicle identification information is entered. Figure 17 shows the VIN number being entered, which identifies

the vehicle. The entering of diagnostic information is satisfied by the disclosure in paragraph 55. See paragraph 42 for a disclosure of comparing the entered information to a symptoms database 90 to determine a prognosis. The results are then displayed as claimed. Databases are used to store the data (for claim 11).

For claim 3, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions.

For claim 6, the means for entering the vehicle identification information and the means for entering the diagnostic information are satisfied by the computer interface 80, that allows entry of the claimed type of data. The means for comparing the entered data is module 30, that compares entered vehicle information to a symptoms database to determine a prognosis. The means for displaying is either the user interface that displays the data or the display of the computer itself that displays the data. A display means is found in Li.

For claims 7,9,12,14, the means to ID service solutions is module 30. This involves repair data.

For claims 8,13, the means to ID warranty solutions is module 41. This includes warranty information.

For claims 10,15, the claimed limitation is directed to non functional descriptive material that does not serve as a limitation. Claims 6 and 9 are apparatus claims directed to the system of the invention. The data that identifies the vehicle is not actually part of the system, but is what the system uses to perform the disclosed

method. This claim is not reciting anything further structurally to the system that is recited in claim 9. The prior art satisfies what is claimed.

For claims 16-19, applicant is reciting method steps of how certain data is being entered, in what the independent claim sets forth as apparatus claims. These steps are not defining any further structure to the system recited in claim 11 but are directed to the intended manner of use, so they are satisfied by Li.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808).

For claim 5, not disclosed is that the entered vehicle identification information is the make, model, and year of the car. In Li, it is disclosed that the VIN (vehicle identification number) is entered. The VIN number represents the make, model, year, and options that the vehicle has. One of ordinary skill in the art would readily appreciate this fact and would have found it obvious to have the vehicle identification information that is entered be the make, model, and year, as claimed. Li discloses the entering of vehicle ID data and modifying Li to accept the make, model, and year, as opposed to the VIN number, is something that one of ordinary skill in the art would have found obvious.

10. Applicant's arguments filed 12/13/06 have been fully considered but they are not persuasive.

With respect to the 112,2nd rejection and the 101 rejection, the amendment to claims 16-19 does not correct the problem of claiming method steps in apparatus type of claims. In the opinion of the examiner, claims 16-19 are still reciting a method step of using recited structure (i.e. the data input receives vehicle diagnostic data over a wireless communications link). Applicant has not explained why the rejection has been overcome by the new claim language, which is still reciting a method step. The rejection is being maintained.

Applicant has argued that in Li, "*The information inputted by the customer is not diagnostic information from a vehicle analyzer and/or the onboard monitor as shown, for example, on FIG. 1.*". This argument is not commensurate with the scope of the claims

because all that the claims recite is the entering of this information. It is not claimed that the information is coming from a "*vehicle analyzer and/or the onboard monitor*" as has been argued. The claim scope allows for a person to enter the claimed information, contrary to what has been argued. This argument is non-persuasive.

With respect to the arguments in paragraph 2 on page 12, they amount to just a mere allegation of patentability and are found to be non-persuasive. This is because all that is argued is a conclusion by applicant with no explanation being provided to explain the position of applicant. The examiner does not see any real argument presented that explains why the rejection is in error. Why does Li not satisfy what is claimed? Statements such as those in paragraph 2 are purely conclusionary in nature, and do not explain to the examiner why Li does not teach what is claimed. The argument is non-persuasive.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER